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REMARKS

The Examiner has acknowledged that the information disclosure statement (IDS) submitted on December 24, 2004 has not been considered, since such references have not been scanned. If, at the time of receipt of the present action, such IDS is still not available, the Examiner is requested to contact applicant in order to have the IDS faxed directly to the Examiner.

The Examiner has rejected Claims 1-13 and 18-43 under 35 U.S.C. 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Throughout such rejection, the Examiner has objected to the "is capable of" language. In response to the Examiner's rejection, such language has been clarified hereinabove.

Further, the Examiner argues queries what applicant means by "accessible" and "made accessible" in the context of the claimed "wherein the manually entered notes, at least one of the manually selected files, and the patents are accessible by subsequent selection of the at least one identifier," and "wherein the notes and at least one of the files are made accessible to other parties utilizing e-mail." In response, applicant points out the plain and ordinary meaning of the term "accessible," which is evidenced by the exemplary definition set forth hereinbelow:

ac·ces·si·ble adj. "Easily obtained"

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The Examiner continues by arguing that the following subject matter is unclear: "wherein the at least one identifier is determined by adding the at least one identifier by entering the at least one identifier" (see Claim 3, for example); "wherein the patents are associated manually" (see Claim 25, for example); and

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“wherein the patents are manually entered via a registration interface” (see Claim 26, for example). Applicant respectfully disagrees with this rejection, as such rejections are moot in view of the cancellation of such related claims made hereinabove.

The Examiner has rejected Claims 1-13 and 19-43 under 35 U.S.C. 101 because the claimed invention is allegedly directed to non-statutory subject matter.

Specifically, the Examiner argues that “[i]n the present case, as to technological arts recited in the preamble, mere recitation in the preamble (i.e. intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble. In the present case, the applicant states that it is a method utilizing a computer implemented system. The body of the claim language has a wherein clause which states that wherein said method, at least in part, is carried out utilizing the computer-implemented system.”

Applicant respectfully disagrees. There is plenty of evidence, in each of the independent claims, that the invention is within the technical arts. Just by way of example, there is multiple “storing” operations, “displaying” operations, and “accessing” operations that significantly depart from the abstract.

The Examiner has further rejected Claims 1-13 and 18-43 under 35 U.S.C. 103(a) as being unpatentable over Rivette et al. (US 2003/0046307). Applicant respectfully disagrees with such rejection.

It appears that the excerpts from Rivette relied upon by the Examiner are deficient in numerous respects. For example, the Examiner relies on the following excerpts from Rivette to make a prior art showing of applicant’s claimed “displaying a technology mapping depicting at least one category of technology utilizing a graphical user interface, displaying statistics regarding a number of the patents of the

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set in each category of technology" (see this or similar, but not identical, language in each of the independent claims, as amended).

"[0025] The processing automatically performed by the invention relates to (but is not limited to) patent mapping, document mapping, document/patent citation both forward and backward), document/patent aging, patent bracketing/clustering (both forward and backward), inventor patent count, inventor employment information, and finance. Other functions also fall within the scope of the invention.

[0262] For example, a patent's value may be linked to whether it covers technology that the corporation is currently using, or that the corporation may use in the future. For this and other purposes, the present invention includes functions for automatically analyzing the patent information 204 in conjunction with manufacturing information 208 and/or R & D information 206. Also, a patent's value may be linked to whether it has generated licensing revenue. For this and other purposes, the present invention includes functions for automatically analyzing the patent information 204 in conjunction with the licensing information 214. Further, a patent's value may be linked to the degree of success of the corporation's commercial products related to the patent (i.e., the commercial embodiments of the patented technology). For this and other purposes, the present invention includes functions for automatically analyzing the patent information 204 in conjunction with the financial information 216.

[0277] FIG. 3 is a block diagram of a system 302 according to an embodiment of the invention. The system 302 includes a plurality of databases 316 that store patent information and other information, such as R & D (research and development) information, financial information, licensing information, manufacturing information, HR (human resources) information, and any other information that may be pertinent to the analysis of the patent information. The terms "database" and "table" are used synonymously herein."

After a careful review of such excerpt, however, it is clear that Rivette merely suggests linking value to a patent based on an associated technology. There is not even a suggestion, in such excerpt, of any sort of displaying a technology mapping depicting at least one category of technology utilizing a graphical user interface (emphasis added), let alone displaying statistics regarding a number of the patents of the set in each category of technology (emphasis added), as claimed, in combination with the remaining claim elements.

Further, the Examiner relies on the following excerpt from Rivette to make a prior art showing of applicant's claimed "wherein the first additional information

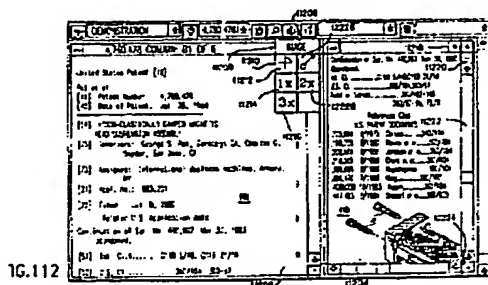
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includes a list of the patents of the set associated with one category of technology” (see this or similar, but not identical, language in each of the independent claims, as amended).

*[0331] Information on groups is stored in the group databases 621. Generally, a group is a data structure that includes any number of documents that typically follow a common theme or characteristic (although this is not a mandatory requirement of groups). More particularly, a group is a data structure that includes any number of patents that typically follow a common theme or characteristic (although, again, this is not a mandatory requirement of groups). Groups are document-centric, or in many cases, patent-centric.”

After a careful review of such excerpt, however, it is clear that Rivette merely links value to a patent based on a technology. There is not even a suggestion, in such excerpt, of any sort of first additional information (that is displayed upon the selection of an icon, as claimed) including a list of the patents of the set associated with one category of technology (emphasis added), as claimed, in combination with the remaining claim elements.

Still yet, the Examiner relies on the following excerpt from Rivette to make a prior art showing of applicant's claimed “wherein the statistics are displayed in a first interface, the first additional information is displayed in a second interface separate from the first interface, and the second additional information is displayed in a third interface separate from the first interface and the second interface” (see this or similar, but not identical, language in each of the independent claims, as amended).



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As mentioned earlier, Rivette fails to even suggest applicant's claimed applicant's statistics and first additional information, as claimed, and thus can simply not meet the present claim language incorporating the same. There is not even a suggestion, in the cited excerpt, of any sort of statistics (as claimed) displayed in a first interface, first additional information (as claimed) is displayed in a second interface separate from the first interface, and the second additional information (as claimed) is displayed in a third interface separate from the first interface and the second interface (emphasis added), as claimed, in combination with the remaining claim elements.

The Examiner goes onto admit that Rivette fails to explicitly disclose a technology mapping depicting at least one category of technology or wherein the first additional information includes a list of the patents of the set associated with one category of technology, or wherein the second additional information is selected from the group consisting of a patent number, a status, an exemplary claim, and an exemplary figure, or wherein the statistics are displayed in a first interface, the first additional information is displayed in a second interface separate from the first interface, and the second additional information is displayed in a third interface separate from the first interface and the second interface, or wherein the notes and at least one of the files are made accessible to other parties utilizing e-mail; as claimed by applicant.

The Examiner goes onto simply dismiss such novel limitations as being nonfunctional descriptive material and not functionally involved in the acts or structure recited. The Examiner goes on to argue that the data does not alter how the system functions or the acts are performed.

Applicant vehemently disagrees with the Examiner on this point. By requiring the very specifically claimed manner (i.e. separate interfaces, etc.) in which the acts are performed (i.e. separate icons, etc.), a significantly improvement manner of organizing, displaying, and accessing patent-related information is achieved.

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To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991).

Applicant respectfully asserts that at least the first and third element of the *prima facie* case of obviousness has not been met, since the prior art references, when combined, fail to teach or suggest *ALL* the claim limitations, and in view of the advantages associated with such novel claim limitations.

Again, a notice of allowance or a specific prior art showing of all of applicant's claim limitations, in combination with the remaining claim elements, is respectfully requested.

The Examiner concludes by arguing that Applicant's arguments fail to comply with 37 CFR 1.111 (b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Applicant respectfully disagrees. Specifically, reiterated below, are arguments (that were previously submitted, at least part), which clearly point out how the language of the claims patentably distinguishes them from the references, in specific terms of the claim language for which the Examiner has still not been able to make a specific prior art showing.

Applicant further argues that many benefits arise from the synergy of the technology mapping, and the remaining claimed framework. Specifically, a user is capable of associating patents with at least one identifier (with additional notes associated therewith), and also obtaining technology-related metrics regarding a set

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of patents, with one framework that is more effectively organized. Specifically, only applicant teaches and claims such a drill-down technique for accessing information relating to the patents subject to the technology mapping, which is believed to be unique, when taken in combination with the remaining claim elements.

A notice of allowance or specific prior art showing of each of the foregoing claim elements, in combination with the remaining claimed features, is respectfully requested.

In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 505-5100. For payment of any fees due in connection with the filing of this paper, the Commissioner is authorized to charge such fees to Deposit Account No. 50-1351 (Order No. SVIPGP002B).

Respectfully submitted,

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